

## **REMARKS**

Applicant respectfully requests reconsideration of the present U.S. Patent application as amended herein. Claims 1-11 were elected without traverse by Mr. Gregory Caldwell during a December 16, 2005 telephone conversation with the Examiner. Claims 1-5 and 7-10 have been amended. Claims 12-30 have been withdrawn. Claim 31 has been added. Thus, claims 1-11 and 31 are pending.

### **35 U.S.C. §112 Rejections**

#### **35 USC § 112 second paragraph**

Claims 2, 3, and 8-11 were rejected under 35 USC §112 second paragraph “as being indefinite for failing to particularly point out and distinctly claim the subject matter.” The Office Action suggests that the phrase “in all but one direction” can be confused with the phrase “in at least one direction.” The applicant requests that claims 1-5 and 7-10 be amended to read according to the foregoing listing of claims.

The applicant respectfully submits that the amended claim 1 particularly points out and distinctly claims a first and second direction of restraint for each of the permanent magnetic blocks. The requested amendments to claim 1 and to its dependent claims eliminate any potential confusion concerning the respective directions of restraint. The amendments are supported in the original disclosure at least by FIG. 5, which illustrates various permanent magnets being restrained each in at least two different directions of motion, where one direction of motion is brought about by the adjacency of another magnet. In light of these amendments,

the applicant requests that the rejection of claims 2, 3 and 8-11 based on 35 U.S.C. § 112, second paragraph be withdrawn.

### **35 U.S.C. §102 Rejections**

#### **35 USC § 102(b) rejection over Hatayama**

Claims 1, 2, 4, 5 and 8 are rejected under 35 USC §102(b) as being anticipated by U.S. Patent Number 4,470,131 issued to Hatayama et. al. (Hatayama). To establish anticipation under 35 U.S.C. §102, the Office Action must supply a single prior art document that alone teaches “. . . every aspect of the claimed invention either explicitly or impliedly.” (See M.P.E.P. §706.02) If the Office Action cannot show that the single prior art document asserts each and every element and limitation of the applicants’ claims, then the Action has failed to establish anticipation under 35 U.S.C. §102(b) for that claim. To overcome such an anticipation rejection, the applicants must only demonstrate that the cited prior art document fails to teach one element or limitation present in the claim.

Hatayama states that a bias field is created in a bubble memory device by placing the bubble memory between two permanent magnets. FIGS. 3 and 5 of Hatayama show a pair of permanent magnets 7a, 7b on opposing sides of a cavity 12. Dividing the space between the two magnets are an insulating substrate 1, a bubble memory chip 2, and two sets of driving coils 3a, 3b. When finally positioned, the permanent magnets are not adjacent to each other or the intervening memory device components. The later insertion of a molding resin into the cavity does not bring the permanent magnets into adjacency.

Applicant respectfully submits that Hatayama does not teach every element of the claims 1, 2, 4, 5 and 8 as amended. Claim 1 recites placing of the second permanent magnet block adjacent to the first permanent magnet block. Since Hatayama shows placement of the bubble memory circuitry between the two permanent magnets, with layers of molding resin dividing the two magnets and the circuitry each from the other, it does not disclose adjacent magnets. For at least these reasons, applicant requests that the 35 U.S.C. § 102(b) rejection of claim 1 and dependent claims 2, 4, 5 and 8 based on Hatayama be withdrawn. It is the applicant's understanding that the amending of claims 5, 8 and 9 to directly depend from claim 1 does not limit the foregoing arguments.

**35 USC § 102(b) rejection over Baermann**

Claims 1-5 and 8-11 were rejected under 35 USC §102(b) as being anticipated by U.S. Patent Number 4,638,281 issued to Baermann. The Office Action suggests Baermann discloses a method which restrains a permanent magnet in a nonmagnetic roll, brings a second nonaligned permanent magnet in proximity to the first magnet, and secures the second magnet in the nonmagnetic roll. Baermann's method teaches concurrently placing numerous magnets 30 within the recesses 20 of a nonmagnetic roll 12. Each of the magnets is subject to universal positioning within the its respective recess, cf. col. 3, lines 59-65, by selective radial, tangential or rotational adjustment, cf. col. 2, lines 33-35. The method of adjustment comprises variously moving and twisting each of the magnets to attain a desired induction field, cf. 4 lines 16-20. These adjustments require only a suitable holding device, without any requirement that movement be restrained, cf. col 4, lines 20-22. After final positioning of the magnets is completed and the desired induction field is attained, the magnets are fixed in their recesses with

a combination of clamps and injection molding material, cf. col. 4, lines 22-25. In the final positioning, a given magnet may or may not be resting on the walls of its respective recess.

Applicant respectfully submits that Baermann does not teach every element of either claim 1 or any other rejected dependant claim. Amended claim 1 recites placing a permanent magnet adjacent to another permanent magnet and restraining in at least one direction any motion otherwise brought about by that adjacency. By way of contrast, Baermann does not disclose the two adjacent magnets which are recited in the amended claim 1. For at least this reason, the applicant requests that the 35 U.S.C. §102(b) rejection of claim 1 and its dependent claims 2-5 and 8-11 based on Baermann be withdrawn.

**35 USC § 102(b) rejection over Taneda**

Claims 1 and 7 are rejected under 35 USC §102(b) as being anticipated by U.S. Patent Number 5,046,235 issued to Taneda et. al. (Taneda). The Office Action suggests that FIG. 1 of Taneda discloses restraining one permanent magnet 1L, restraining that magnet with a 3-axis ball screw driven slide, bringing a second nonaligned magnet into proximity of the second magnet 1R, and similarly restraining the second magnet.

Taneda discloses construction of a transformer core by magnetizing layers of a U-shaped laminate and sequentially allowing the ends of each layer to bend into contact with each other. FIG. 1 of Taneda discloses a laminate of magnetic material 1, with a right end and a left end labeled 1r and 1l. These ends are bent to fit through coils 2a, 2b which will magnetize the laminate. After magnetization, restraints on the two ends 1r, 1l are sequentially removed from the ends of each successive layer of laminate to allow the two ends to be brought into abutment

by virtue of their magnetic attraction to one another. The sequential process performed for each layer of the laminate comprises the overall method disclosed by Taneda.

The applicant respectfully submits that neither the separate process nor the overall method disclosed by Taneda contains all of the elements of the present invention. Specifically, Taneda does not disclose an adjacency of two magnetic blocks as recited in amended claim 1. Taneda states that 1l and 1r merely refer to opposing ends of the same laminate. The reference does not disclose a second magnetic block or its adjacency to the laminate. For at least these reasons, the applicant requests that the 35 U.S.C. § 102(b) rejection of claims 1 and 7 based on Taneda be withdrawn.

### **35 U.S.C. §103(a) Rejections**

#### **35 USC § 103(a) rejection over Baermann**

Claim 6 was rejected under 35 U.S.C. § 103(a) for obviousness under Baermann. The Office Action suggests that Baermann discloses the elements of the independent claims, and that the additional limitations of claim 6 would be obvious within the level of ordinary skill in the art of assembling permanent magnetic blocks. The applicant respectfully submits that amendments to the independent claims from which claim 6 depends are not disclosed by Baermann, for reasons already discussed. At least for this reason, applicant requests that the 35 U.S.C. § 103(a) rejection of claim 6 based on Baermann be withdrawn.

**New Claims**

Applicant has added new claim 31, which depends upon claim 1. It is Applicant's understanding that new claim 31 is allowable in view of the references cited by the Examiner. New claim 31 is supported in the original disclosure at least in the specification on page 3, lines 7-12.

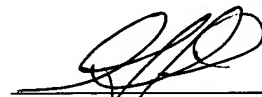
**Conclusion**

For at least the foregoing reasons, Applicants submit that the objections and rejections have been overcome. Therefore, claims 1-11 are in condition for allowance and such action is earnestly solicited. New claim 31 is submitted for the Examiner's consideration. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,  
**BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP**

Date: \_\_\_\_\_

3/31/06



\_\_\_\_\_  
Gregory D. Caldwell  
Attorney for Applicant  
Reg. No. 39,926

12400 Wilshire Boulevard  
Seventh Floor  
Los Angeles, CA 90025-1026  
(503) 439-8778